

**Remarks**

Entry of the above-noted amendments, reconsideration of the application, and allowance of all claims pending are respectfully requested. By this amendment, claims 1, 3, 6, 10-13, 15-20 are amended, claim 2 is canceled, and claims 21-25 are added. These amendments to the claims constitute a bona fide attempt by applicant to advance prosecution of the application and obtain allowance of certain claims, and are in no way meant to acquiesce to the substance of the rejections. Support for the amendments can be found throughout the specification (e.g., page 5, line 16, to page 7, line 19; page 8, line 19, to page 9, line 10; page 12, line 19, to page 13, line 2; page 15, line 14, to page 16, line 11), figures (e.g., FIGS. 1 and 2), and claims and thus, no new matter has been added. Claims 1 and 3-25 are pending.

**Claim Rejection - 35 U.S.C. § 102:**

Claims 1, 3-16, and 18-20 are rejected under 35 U.S.C. § 102(e) as being anticipated by Lin et al. (U.S. Patent Publication No. 2003/0114154; "Lin"). This rejection is respectfully, but most strenuously, traversed.

It is well-settled that there is no anticipation unless (1) all the same elements are (2) found in exactly the same situation and (3) are united in the same way to (4) perform the identical function. Since the Office Action's citations to the applied reference are missing at least one element of each of applicants' independent claims, applicants respectfully submit that the claimed invention is not anticipated by the Office Action's citations to the applied reference, as further discussed below.

For explanatory purposes, applicants discuss herein one or more differences between the Office Action's citations to the applied reference and the claimed invention with reference to one or more parts of the applied reference. This discussion, however, is in no way meant to

acquiesce in any characterization that one or more parts of the Office Action's citations to the applied reference correspond to the claimed invention.

Applicants respectfully submit that the Office Action's citations to the applied reference do not teach or suggest one or more elements of the claimed invention. A careful reading of the Office Action's citations to the applied reference fails to teach or suggest, for example, the serving mobile switching center that employs the established telephone number to connect the call to the roaming mobile device, wherein the serving mobile switching center connects the call to the roaming mobile device without allocation of a temporary roaming number for the roaming mobile device, as recited in applicants' independent claim 1.

Claim 1 has been amended to recite that "the serving mobile switching center connects the call to the roaming mobile device without allocation of a temporary roaming number for the roaming mobile device," which originally appeared in claim 2. Lin discloses the use of temporary roaming numbers to connect calls to roaming mobile devices. For example, in paragraph 0003, Lin discloses that "[i]n order to route a call to a MS that is outside of the home area of the subscriber's service provider, a roaming number must be used." This point is even conceded by the Office Action (page 3): "Lin discloses all the subject matter described in rejected claim 1, except for connects the call to the roaming mobile device without allocation of a temporary roaming number for the roaming mobile device."

So, the Office Action's citation to Lin fails to satisfy at least one of the limitations recited in applicants' independent claim 1.

For all the reasons presented above with reference to claim 1, claims 1, 13, 20 are believed neither anticipated nor obvious over the art of record. The corresponding dependent

claims are believed allowable for the same reasons as independent claims 1, 13, 20, as well as for their own additional characterizations.

Withdrawal of the § 102 rejection is therefore respectfully requested.

Claim Rejection - 35 U.S.C. § 103:

Claims 2 and 17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Lin in view of Lantto et al. (U.S. Patent No. 5,537,457; "Lantto"). This rejection is respectfully, but most strenuously, traversed. Claim 1 has been amended to recite that "the serving mobile switching center connects the call to the roaming mobile device without allocation of a temporary roaming number for the roaming mobile device," which originally appeared in claim 2.

Applicants respectfully submit that when undertaking an inquiry into the obviousness of a claimed invention, a determination must be made regarding whether, at the time the claimed invention was made, the claimed invention would have been obvious to one of ordinary skill in the art to which the subject matter of the invention pertains. Applicants strenuously traverse the § 103 rejection on the following bases:

- (1) Lin is not properly combinable with Lantto in the manner suggested by the Office Action because its intended function would be destroyed;
- (2) Lin teaches away from the claimed invention; and
- (3) There is no basis in the art for combining or modifying Lin and Lantto in the manner suggested by the Office Action.

First, Lin is not properly combinable with Lantto in the manner suggested by the Office Action because its intended function would be destroyed. If a prior art reference requires some modification in order to meet the claim limitations or requires some modification in order to be

properly combined with another reference and such a modification destroys the purpose or function of the invention disclosed in the prior art reference, then one of ordinary skill in the art would not have found reason to make the claimed modification and the *prima facie* case of obviousness can not be properly made.

Lin discloses a system to prevent unauthorized use of temporary roaming numbers in a wireless telecommunications system. The Mobile Switching Centers ("MSCs") in Lin each have a pool of available temporary roaming numbers that they can allocate to roaming subscribers served by those MSCs. If a malicious user identified which telephone numbers were used by an MSC as temporary roaming numbers, then that malicious user could dial those numbers directly to interfere with the allocation by the MSC of the temporary roaming numbers. The purpose and function of Lin's invention is to provide an authentication system to prevent a malicious user from performing such an disturbance to the use of temporary roaming numbers. Therefore, the use of roaming numbers is integral to the operation of Lin's invention.

However, the Office Action asserts (page 4) that one having ordinary skill in the art would combine Lin with Lantto to eliminate the use of temporary roaming numbers. This combination to eliminate the use of temporary roaming numbers would also eliminate the need for Lin's invention. For example, the combination would destroy the intended function disclosed in Lin. Therefore, Lin is not properly combinable with Lantto in the manner suggested by the Office Action.

Second, Lin teaches away from the claimed invention. Teaching away from claimed limitations prevents a purported § 103 rejection from rising to a case of *prima facie* obviousness. Lin discloses (paragraph 0003) that "[i]n order to route a call to a MS that is outside of the home area of the subscriber's service provider, a roaming number *must* be used." (emphasis added).

Furthermore, the reference is replete with descriptions of allocating temporary roaming numbers to roaming subscribers. Therefore, one of ordinary skill in the art would not think to go in the opposite direction in the manner suggested by the Office Action.

Third, there is no basis in the art for combining or modifying Lin and Lantto in the manner suggested by the Office Action. It is well settled that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion that the combination be made.

The Office Action states (page 4) as a justification to combine Lin and Lantto:

[I]t would have been obvious to one having ordinary skill in the art at the time the invention was made to use Lantto's connects the call to the roaming mobile device without allocation of a temporary roaming number in order to handle calls to a non-registered terminal in a mobile telephone system or particularly in a system which operates without specific roaming numbers.

This justification for combining Lin and Lantto conspicuously fails to identify any express teaching, suggestion, or incentive in the art for making the combination. Applicants respectfully submit, upon review, that Lin and/or Lantto fail to provide any express teaching, suggestion, or incentive.

Either the Office Action must identify an express teaching, suggestion, or incentive in the art, or the Office Action must present a convincing line of reasoning as to why one skilled in the art would have found the claimed invention to have been obvious. Since no express teaching or suggestion in the art has been identified, attention must be turned to the reasoning to determine whether it is convincing regarding whether the invention is obvious.

In this regard, the justification is nothing more than hindsight restatement of the results of the present invention. Further, since this justification is hindsight reconstruction of the results of the present invention, the Office Action's reasoning is actually using the present invention itself

as a basis to combine Lin and Lantto. This violates the settled principle that a motivation to modify a reference cannot come from the invention itself.

Applicants respectfully submit that the claimed invention would not have been obvious, namely, no express teaching or suggestion in the documents for the combination has been identified, and further, the justification given in the Office Action for combining Lin and Lantto is not convincing since it is nothing more than hindsight reconstruction of the present invention using pieces of the documents to fill the gaps.

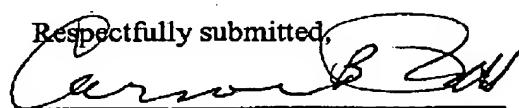
Furthermore, the Office Action does not allege that the art of record provides any teaching, suggestion, or incentive for modifying the citations to Lin and/or Lantto to provide the claimed configuration.

For all the reasons presented above with reference to claim 1, claims 1, 13, 20 are believed neither anticipated nor obvious over the art of record. The corresponding dependent claims are believed allowable for the same reasons as independent claims 1, 13, 20, as well as for their own additional characterizations.

Withdrawal of the § 103 rejection is therefore respectfully requested.

In view of the above amendments and remarks, allowance of all claims pending is respectfully requested. If a telephone conference would be of assistance in advancing the prosecution of this application, the Examiner is invited to call applicant's attorney.

Respectfully submitted,



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